

R E M A R K S

Claims 1 to 4, 9 to 14 and 16 to 25 as set forth in Appendix I of this paper are now pending in this case. Claim 15 has been canceled, Claims 1 to 4, 9 to 14 and 16 to 19 have been amended, and Claims 20 to 25 have been added, as indicated in the listing of the claims.

More specifically, applicants have amended Claims 1 and 16 to relate to a cosmetic or dermatological sunscreen preparation for protecting human skin against solar rays.<sup>2)</sup> Claims 2 to 4, 9 to 14 and 17 to 19 have been revised accordingly. New Claims 20 to 23 have been added to bring out embodiments of the preparation defined in Claim 16 which are correspondingly specified in Claims 17 to 19 and 12, respectively. New Claims 24 and 25 have been added to further bring out some of the embodiments of the preparations of Claims 1 and 16 which are addressed on page 17, indicated lines 17 to 24, of the application. No new matter has been added.

The Examiner rejected Claims 1 to 4 and 9 to 19 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Dieing et al.* (EP 0 893 117) when taken in view of the disclosure of *Dupuis et al.* (US 5,553,630) or when taken in view of the disclosure of *Eteve et al.* (US 5,643,557). It is respectfully solicited that the Examiner favorably reconsider her position in light of the foregoing changes in the claims and the following remarks.

The United States Supreme Court has recently noted that the analysis under 35 U.S.C. §103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."<sup>3)</sup> However, the Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" and cautioned that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."<sup>4)</sup>

2) Cf. Claim 15 and page 2, indicated lines 1 to 4, of the application.

3) KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, \_\_\_, 82 USPQ2d 1385, 1397 (2007).

4) KSR, 127 S.Ct. at \_\_\_, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

The references upon which the Examiner relied in the rejection are not deemed to provide an apparent reason to combine known elements in the fashion claimed, and the combination of the elements found in the cited references clearly does not result in the particular arrangement which is required in accordance with applicants' invention. As such, the teaching of *Dieing et al.* taken in view of the disclosure of *Dupuis et al.* or of *Eteve et al.* is not deemed to establish that the subject matter of applicants' claims is unpatentable under Section 103(a).

The Examiner pointed out that *Dieing et al.* teach cationic cross-linked polymers corresponding to applicants' component (A) for use in hair care compositions,<sup>5)</sup> and that *Dupuis et al.* disclose the use of coated and uncoated metallic oxides corresponding to applicants' component (B) in hair care compositions.<sup>6)</sup> On this basis, the Examiner concluded that it would have been prima facie obvious for a person of ordinary skill in the pertinent art to modify the hair care compositions of *Dieing et al.* by incorporating the metal oxides mentioned by *Dupuis et al.* in order to protect hair against UV rays.<sup>7)</sup>

It is respectfully submitted that both *Dieing et al.* and *Dupuis et al.* pertain to hair care compositions whereas applicants' claims are drawn to preparations for protecting human skin against solar rays. Neither the teaching of *Dieing et al.* nor the disclosure of *Dupuis et al.* contains anything which suggests a skin care composition comprising the cationic polymer corresponding to component (A) in combination with the inorganic UV filter component (B) which is required in accordance with applicants' invention.

It is further respectfully submitted that a person of ordinary skill who considered the references as a whole for what they reasonably conveyed at the time the invention was made, would not have been motivated to make the modification put forth by the Examiner and would not have arrived at the subject matter of applicants' claims. *Dieing et al.* explain that the polymers corresponding to applicants' component (A) are particularly suitable for use as conditioning agents in shampoo formulations,<sup>8)</sup> i.e. that the polymers are useful in hair care products which are specifically adapted to be rinsed off.

5) Office action page 2, lines 15 to 24.

6) Office action page 3, lines 2 to 5.

7) Office action page 3, lines 11 to 16.

8) Cf. page 11, indicated lines 4 and 5, of the English language translation.

In contrast thereto, *Dupuis et al.* employ the pigments in "a non-rinse cosmetic support,"<sup>9)</sup> i.e. the pigments are provided in hair care products which are specifically adapted to remain in the hair rather than being rinsed off. In view of these distinct differences of the products with which *Dieing et al.* and *Dupuis et al.* are concerned, it is respectfully submitted that a person of ordinary skill in the art would not have been motivated to incorporate a pigment, which is according to *Dupuis et al.* useful in non-rinse products for protecting hair, in a rinse-off product as addressed in the disclosure of *Dieing et al.*

The teaching of *Dieing et al.* when taken in view of the disclosure of *Dupuis et al.* is, therefore, not deemed to render the cosmetic or dermatological sunscreen preparation for protecting human skin against solar rays which is claimed by applicants *prima facie* obvious under Section 103(a). Favorable action by the Examiner is respectfully solicited.

The teaching of *Dieing et al.* taken in view of the disclosure of *Eteve et al.* is deemed to be equally unsuited to render applicants' skin protection preparation *prima facie* obvious.

The Examiner pointed out that *Dieing et al.* teach cationic cross-linked polymers corresponding to applicants' component (A) for use in hair care compositions,<sup>10)</sup> and that *Eteve et al.* disclose the use of coated and uncoated metallic oxides corresponding to applicants' component (B) in hair care and skin care compositions.<sup>11)</sup> On this basis, the Examiner concluded that it would have been *prima facie* obvious for a person of ordinary skill in the pertinent art to modify the compositions of *Dieing et al.* by incorporating the metal oxides mentioned by *Eteve et al.* in the hair care products of *Dieing et al.* in order to protect hair against UV rays.<sup>12)</sup>

However, following the rationale underlying the Examiner's argument, a person of ordinary skill would have arrived at a rinse-out product for the protection of hair and not at the preparation for the protection of skin against solar rays which is referenced in applicants' claims.

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9) Cf. col. 2, indicated lines 39 to 42, of *US 5,553,630*; see also col. 3, indicated lines 31 to 33, of the reference.

10) Office action page 2, lines 15 to 24.

11) Office action page 3, lines 6 to 9.

12) Office action page 3, lines 11 to 16.

Moreover, it is well settled that the "invention as a whole" which is referenced in 35 U.S.C. 103(a) is not limited to the particular elements which are recited in a claim but also encompasses the properties which are inherent in the claimed combination of elements.<sup>13)</sup>

Applicants' skin protecting preparations exhibit certain particular properties which could clearly not be expected in light of the references.<sup>14)</sup> Applicants have, for example, found that the polymers (A) further stabilize the skin care preparations comprising the inorganic UV filters (B).<sup>15)</sup> As shown by the investigations described in the application,<sup>16)</sup> a water/oil cream emulsion in accordance with applicants' invention which contained 0.5% by weight of a polymer component (A) in combination with 5% by weight of zinc oxide was colloiddally stable whereas a corresponding composition which lacked the polymer component (A) was not stable. Applicants have also found that the presence of the polymer component (A) in combination with the pigment component (B) distinctly increases the sun protection factor of the preparation as compared with a preparation comprising the pigment component (B) but lacking the polymer component (A).<sup>17)</sup> The distinct impact of the presence of the polymer component (A) on the sun protection factor which is achieved by a preparation comprising the pigment(s) (B) is illustrated by application example 1.<sup>18)</sup> Accordingly, a sunscreen cream comprising zinc oxide in an amount of 5% by weight exhibited a sun protection factor of 15, whereas a corresponding composition in accordance with applicants' invention which contained 5% by weight of zinc oxide as pigment(s) (B) in combination with 0.5% by weight of the polymer component (A) achieved a sun protection factor of 20.

Neither the teaching of *Dieing et al.* nor the disclosure of *Eteve et al.* contain anything which suggests or implies that polymers corresponding to component (A) of applicants' preparation are suitable to stabilize a skin protection composition which comprises an inor-

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13) *In re Antonie*, 559 F.2d 618, 620, 195 USPQ 6 (CCPA 1977).

14) Cf. page 2, indicated lines 1 to 4, of the application.

15) Cf. page 17, indicated lines 13 to 15, of the application.

16) Cf. application example 2 on page 27, indicated line 4, to page 28, indicated line 11, of the application.

17) Cf. page 17, indicated lines 17 to 24, of the application. See also Claims 24 and 25.

18) Cf. page 25, indicated line 43, to page 27, indicated line 2, of the application.

ganic UV filter corresponding to component (B) of applicants' preparation, or that the polymers corresponding to component (A) of applicants' preparation are suitable to increase the sun protection factor which can be achieved by a skin protection composition which comprises an inorganic UV filter corresponding to component (B). It is well settled that obviousness cannot be predicated on what is unknown.<sup>19)</sup> Therefore, the teaching of *Dieing et al.* and the disclosure of *Eteve et al.* cannot be deemed to render applicants' invention as a whole unpatentable under Section 103(a).

In light of the foregoing and the attached, it is respectfully requested that the rejections based on the teaching of *Dieing et al.* and the disclosures of *Dupuis et al.* and *Eteve et al.* be withdrawn. Favorable action is solicited.

The subject matter defined in in applicants' claims is deemed to be patentable under the pertinent provisions, and the application meets the requirements relating to the form or contents which are applicable in the present case. Allowance of the application should therefore be equitable.

In the event that the Examiner is of the opinion that further explanations or clarifications are necessary or desirable in this matter, applicants would greatly appreciate it if the Examiner would grant their representative the opportunity address such matters in a personal interview to facilitate the proceedings.

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19) *In re Adams*, 356 F.2d 998, 148 USPQ 742 (CCPA 1966); *In re Spormann*, 363 F.2d 444, 150 USPQ 449 (CCPA 1966); *In re Shetty*, 566 F.2d 81, 195 USPQ 753 (CCPA 1977); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989); *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).